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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/762,104

Applicant(s)

GAUTHIER ET AL.

Examiner

TAMRA L. DICUS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/14/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The RCE is acknowledged.

The following is withdrawn:

Claim Objections

- Claims 1-9 are objected to because of the following informalities: the amended phrase “the leather decorative layer”, is not consistent with the “decorative layer consisting essentially of a leather material”. It is not clear if the decorative layer is completely of leather or just a percentage of leather. The same language is suggested for all terms for consistency. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following rejections are maintained and/or introduced below:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/762,103 in view of Scher. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application contain the subject matter that is narrower in scope than that in the instant claims, rendering them obvious over each other. Further

a difference between using phenolic or melamine based formaldehyde impregnates are taught by Scher at 5:15-25 to be suitable for using in paper or cellulosic based papers, thus choosing one over the other would have been an obvious choice for creating a decorative laminate.

This is a provisional obviousness-type double patenting rejection.

Claims 1-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 7,179,538 whether alone, or in view of Hiers et al. (US Pat. 4,132,821).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the patented claims is narrower than that of the instant claims, rendering them obvious over each other.

In regards to instant claims 1-9, the patent contains all the limitations in the instant claims, despite a wording of backing layer vs. substrate, they have the same meaning. However, the patented independent claims 1, 2, and 3 include the flexible backing layer in addition to the leather layer and the decorative layer of instant claim 1, and the backing is considered equivalent to the instant substrate. Thus, the scope of the instant claims embraces that of the patented claims, rendering them obvious over each other.

- Applicant argues it is premature for a Terminal Disclaimer. For this reason, both ODP rejections stand. Applicant argues the term “flexible” is left out of the instant claims while in the ‘538 patent cited in full above. However, this is not convincing

because flexibility is an obvious feature as it is a property and the instant claims are more broad, which read on the more narrow patented claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,440,538 to Ungar in view of US 1,672,537 to Novak or US 5,534,237 to Nishi et al.
2. Ungar teaches an abrasion resistant laminate wherein a wear resistant upper layer is made under high pressure and temperature (4:35-45), the first wear layer 6 (shown in Fig. 2, laminated and apart of 12 of Fig. 3) may be made according to Lane or Mehta (6:23-35) using impregnated paper (5:35-40) or produce a melamine (resin) saturated paper (embraces impregnated) (6:35-40) or produce a melamine impregnated alpha cellulose or paper sheet (6:45-50). Further the decorative layer 7 under wear layer 6 is also impregnated with melamine resin (6:60-68) as is the core layer 8 (all layers 6, 7, and 8 represent an overlayer, underlayer, substrate, and backer as claimed). Both layers 7 and 8 are also of paper (embraces cellulose, see 7:1-45). At least four impregnated paper layers are used (see also Fig. 6, layers 8A-8D illustrating four for the core and where a total of six possible impregnated paper layers are employed –equating to instant claim 6 use of first and second decorative and underlayers) and the wear layer is decorative (see Abstract). See also the additional

functionality of layer 6 also being an overlay to protect the decorative layer 7 (6:47-55). Claims 1, 3, 5 are addressed.

3. Ungar does not teach a decorative layer consisting essential of a leather material.

4. Novak teaches a floor covering built up of plys of leather shavings as the surface coat (2:55-75) and put on a paper machine for mixing fibers with the leather during the paper making operation and sheeted under application of heat and pressure into a tough flooring material (2:70-101) for exhibiting superior wearing surface having higher resistance to abrasion (1:40-68). Such description is equivalent to a decorative layer consisting essentially of a leather material.

5. Nishi teaches a powdered leather comprised of at least 85% natural raw leather hide, which can be used and manufactured into a thin film, molded products, coatings or fibers (1:19-35, 2:5-40) and in general, laminates (10:1-68, 11:1-25, maximum 60% of natural raw leather powder, equivalent in meaning to decorative layer consisting essentially of leather material). The laminate uses the leather in the pores of the outermost skin layer, intermediate and substrate layers, where the substrate may be cloth, film, or paper. The leather contained products resultant therefrom the laminate exhibit good touch, and grip material having tactile quality (same reasons as Applicant).

6. It would have been obvious to one having ordinary skill in the art to have modified the printed paper wear layer of Ungar to use, incorporate, or substitute an improved paper leather material as Novak taught it produces superior results such as tough flooring material, wearing and higher resistance to abrasion. Because Ungar was also concerned with abrasion resistance (see the title), it would have been expected that the incorporation of leather material for the reasons Novak taught successfully envisages the instant invention. Additionally, it would have been obvious to

one having ordinary skill in the art to have modified Ungar also to include decorative leather material for Nishi's reasons such as good touch, and grip material having tactile quality.

7. Applicant is directed to the following note to the inclusion of leather material: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, it is not a stretch to envisage leather material in a high pressure laminate as one having skill would expect leather material to aim at the purpose of making it feel soft-to-the-touch. It is well known that leather feels soft.
8. Also note to these points above regarding using leather material: Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozsek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

Regarding the thickness recitation per instant claim 2 the combination does not teach. However, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that

such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). Thickness effects durability and strength.

The references above do not teach a migrated resin from the underlyer, however, since thermosetting resins are impregnated in the same fashion and in the same order, this transition is expected (claim 1).

9. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,440,538 to Ungar in view of US 1,672,537 to Novak or alternatively in view of US 5,534,327 to Nishi et al. and further in view of Nelson (US 6324809).

10. The combinations are applied above.

11. The combinations do not teach a substrate of plywood or particle board or medium density per instant claim 4 .

12. Nelson teaches a similar laminate flooring having a decorative surface of conventional high pressure decorative laminate made from melamine formaldehyde impregnated paper attached to a core via adhesives, wherein the core is of wood based products such as high density fiberboard, polyvinyl chloride (equivalent core material to that used by Ungar), and veneers (embraces plywood) at 3:1-50. See also 5:30-35 and Abstract.

13. It would have been obvious to one having ordinary skill in the art to have modified the combination to substitute, use, or incorporate plywood, particle board, or fiber board because

Nelson teaches said wood based materials are equivalent to polyvinyl chloride used as cores for decorative melamine impregnated paper surface layers in laminate flooring as cited above.

- Applicant argues the Novak patent in this rejection, pointing to the 5.5% calculated leather shavings to base his argument that this is not a decorative layer consisting essentially of a leather material. However, this is not convincing because consisting essentially language is construed as open language and Applicant has not proven a deleterious effect. Such arguments are not persuasive because the prior art provides no indication the material would not function any different from the claimed invention. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52. “A consisting essentially of claim occupies a middle ground between closed claims that are written in a consisting of format and fully open claims that are drafted in a comprising format.” *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir.1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569. Absent a clear indication in the specification or claims of what the basic and novel characteristics actually are (e.g. a percentage of leather), “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355. The prior art includes natural leather in a composition and thus is the same as Applicant claims “leather material”. A lesser amount or percentage of leather does not affect the novelty of the instant invention,

nor does the claim require a greater percentage of leather material. Thus, it is the burden of Applicant to show a deleterious effect on the instant invention.

- For these reasons set forth above, Novak need not play any part in abrasion resistance as Applicant alleges. There is suggestion for leather material of Novak in the Ungar laminate for superior results such as making it tougher and thus stronger. Leather material by itself is decorative.

14. Claims 1-3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher (US 3,700,537) in view of Schlup et al. (US 5,811,122) or alternatively in view of Schmooch (US 5,344,692) or alternatively in view of Hiers et al. (US 4,132,821) or alternatively in view of US 5,534,327 to Nishi et al.

Scher teaches in this order: overlay 20, Fig. 3A and associated text (overlayer), embedment sheet 18, Fig. 3A and associated text (function as decorative layer), print sheet 16, Fig. 3A and associated text (one or more cellulosic sheet impregnated with melamine-formaldehyde resin, functioning as underlay layer), core sheet 14 (top layers), Fig. 3A and associated text (one or more cellulosic sheet impregnated with melamine-formaldehyde resin, function as substrate), core layer 14, (bottom ones) (cellulosic impregnated with the same aforementioned resin - backer layer), and plate 12, Fig. 3A and associated text (second decorative layer of any dimensionally stable material). Claims 1-3, and 5 are addressed.

Scher does not expressly disclose said layers are of a leather material nor a bonded leather (instant claim 1-2), while using it in a laminated composite simulating leather.

However, Scher teaches embedment layer being of almost of any construction (5:35-38), so long as it doesn't melt during lamination (5:50-55).

Schlup teaches a similar leather/polymer composite material used in structural composite (4:39-40) materials to improve hide/leather properties with impregnated polymer systems, such composite material improves several properties surrounding those effected by heat and pressure, namely toughness, machinability, elasticity, compressibility and sealing where Schlup teaches the necessity of such an improvement in the hide and leather industries and laminated composites. See 1:10-20, 2:30-65, patented claims 1-15, Example 2, and Tables 1-2. Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials. Schlup also teaches pressure and heat applications of up to 160 degrees C and 3.8 psig in a hot press (4:15-18, 8:7-25, Tables 1-2 show all properties of using hide/leather alone and with a polymer). Such heat and pressure teachings in conjunction with teachings of use in structural composites serve to produce a similar heat and pressure consolidated laminate like that of Scher.

Schmook teaches a leather-containing composite material used in structural composite materials in application of heat and/or pressure as a low-cost alternative (Abstract, 3:1-40). Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials.

Hiers discloses the use of leather containing animal hides (see 1:6-9) for the hand and feel of natural leather (Abstract) in a non-woven composite (patented claims 1-2) (which is the same reason Applicant uses the leather material) under a hot press enduring heat and pressures of 225 to 500 degrees F and 5 to 500 lbs per sq. in. (see 12:20-30, Example 1, especially lines 45-50 of col. 13).

15. Nishi teaches a powdered leather comprised of at least 85% natural raw leather hide, which can be used and manufactured into a thin film, molded products, coatings or fibers (1:19-35, 2:5-40) and in general, laminates (10:1-68, 11:1-25, maximum 60% of natural raw leather powder, equivalent in meaning to decorative layer consisting essentially of leather material). The laminate uses the leather in the outermost skin layer, intermediate and substrate layers, where the substrate may be cloth, film, or paper. The leather contained products resultant therefrom the laminate exhibit good touch, and grip material having tactile quality (same reasons as Applicant).

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schlup for the purpose of improving several properties surrounding those effected by heat and pressure, namely toughness, machinability, compressibility and sealing where the such an improvement in laminated composites is needed in the hide and leather industries as taught by Schlup (1:10-20, 2:30-40, patented claims 1-15, Example 2, and Tables 1-2.

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schmoock for the purpose of improving several properties surrounding those effected by heat and pressure where such an improvement in laminated composites is a low cost alternative to high-quality leathers as taught by Schmoock (3:1-45, Abstract).

It would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the woven or cloth embedment layer of the laminate of Scher because leather containing animal hides as well as simulated leather have been conventionally used in the art of decorative articles for the hand and feel of natural leather in a non-

woven heat and pressure composite, which is the same reason Applicant uses the leather material as cited above.

Additionally, it would have been obvious to one having ordinary skill in the art to have modified Scher also to include decorative leather material for Nishi's reasons such as good touch, and grip material having tactile quality.

Applicant is directed to the following note to the inclusion of leather material: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, it is not a stretch to envisage leather material in a high pressure laminate as one having skill would expect leather material to aim at the purpose of making it feel soft-to-the-touch. It is well known that leather feels soft.

Also note to these points above regarding using leather material: Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

Regarding the thickness recitation per instant claim 2, Scher does not teach. However, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

The references above do not teach a migrated resin from the underlayer, however, since thermosetting resins are impregnated in the same fashion, this transition is expected (claim 1).

- Applicant argues that since Scher teaches a less expensive look than with leather, then Scher doesn't teach motivation for substituting a natural material such as leather as set forth above. However, Applicant has not claimed a natural leather, but a leather material. Thus Applicant has not limited the claims to only natural leather. The term "leather material" is broadly interpreted. Applicant is welcomed to amend the claims to what he intends. Moreover, Scher teaches at 5:35-38 the embeddment layer being of almost any construction and thus a leather material is one of those constructions not far from the instant claims to yield improvements in toughness and compressibility. Applicant argues Schlup doesn't teach high pressure laminates, however, this reference is not used to teach that as the primary reference Scher teaches that and further the temperatures of Schlup are over 200 degrees, so that is considered high temperature (see col. 2, line 64) and see Example 4 up to 3.8 psig for 1 hour, which is considered high pressure.
- Applicant argues the leather decorative layer (which Applicant does not claim, but a decorative layer comprising a leather material) is not fully impregnated (which is also

not claimed) and not shown in the above rejection. However, the same materials are used in the same layers and thus migration as explained above would naturally flow at some point in time before it is cured, despite Applicant's allegations that a combination would not suggested and would teach away because Scher teaches fully cured and fully impregnated laminates.

- Applicant argues Scher's expenses; however, the same rationale is applied here as explained above.
- Applicant argues other in situ polymerization techniques; however this is not claimed and not relevant to the instant claims.
- Applicant argues Schlup provides no reason to include a decorative layer as claimed, however, for reasons set forth above, the combination is proper. Scher is not limited to the type of embedment layer material it may constitute.
- Applicant argues the teaching of Scher is contradictory in that a leather would not need a print. However, this has not been proven and is speculative and thus do not teach away from combining the references.
- Applicant argues the need and utility of the Scher and Schlup combination pointing to leather again, which is not claimed.
- Applicant argues Schmoock, alleging no impregnated resin or high pressure laminate (HPL) is taught. However, this reference is not used to teach that as the primary reference Scher teaches HPLs. Moreover, Schmoock explicitly teaches heat and pressure applications in the Abstract and 3:1-40, which is equivalent in meaning to HPLs.

- For the reasons above, Scher does not teach away from the use of a decorative layer including leather material (despite Applicant's allegations to the contrary and incorrectly construing the claims to mean a leather decorative layer).
- Applicant argues the use of Hiers, requesting understanding of this rejection. Applicant did not point to a page number and reference point so that the Examiner can reference this in context, however, it means Scher in view of Hiers as set forth above.
- Applicant argues Hiers teaches an object of artificial leather, however, this still reads on "a leather material", further Hiers teaches it is well known to use natural as well as artificial leather for the feel and touch, the same as Applicant, and thus does not only teach artificial type. Applicant is directed to the following note: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, it is not a stretch to envisage leather material in a high pressure laminate as one having skill would expect leather material to aim at the purpose of making it feel soft-to-the-touch. It is well known that leather feels soft.
- Also note to these points above regarding using leather material: Analysis of whether the subject matter of a claim would have been obvious need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court

can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006)). It is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom..." The analysis supporting obviousness, however, should be made explicit and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" in the manner claimed. *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1396. Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Borge*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

16. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher in view of Schlup et al. or alternatively in view of Schmoock (US 5,344,692) or alternatively in view of Hiers et al. (US 4,132,821) or alternatively in view of US 5,534,327 to Nishi et al.

Scher teaches in this order: overlay 20, Fig. 3A and associated text (overlayer), embedment sheet 18, Fig. 3A and associated text (function as decorative layer), print sheet 16, Fig. 3A and associated text (one or more cellulosic sheet impregnated with melamine-formaldehyde resin, functioning as underlay layer), core sheet 14 (top layers), Fig. 3A and associated text (one or more cellulosic sheet impregnated with melamine-formaldehyde resin, function as substrate), core layer 14, (bottom ones) (cellulosic impregnated with the same aforementioned resin - backer layer), and plate 12, Fig. 3A and associated text (second decorative layer of any dimensionally stable material). Claims 6 and 8 are addressed.

Scher teaches embedment layer being of almost of any construction (5:35-38), so long as it doesn't melt during lamination (5:50-55).

Scher does not expressly disclose said layer is of a leather material nor a bonded leather (instant claim 6-7), while using it in a laminated composite simulating leather. Scher does not expressly repeat the layers 20 and 18 to produce a second decorative and second underlayer, however, unless the reference teaches away from reproducing said layers, it is obvious to provide a second combination of decorative layer adjacent a second underlayer motivated by the desire of providing more stability or thickness to the overall structure, as Scher suggests any construction may be the embedment layer, it would have been obvious to be said second layers, especially since the embedment layer is surrounded by one or more cellulosic resin impregnated sheets. Additionally, the mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

Schlup teaches a leather/polymer composite material used in structural composite materials to improve hide/leather properties with impregnated polymer systems, such composite material

improves several properties surrounding those effected by heat and pressure, namely toughness, machinability, compressibility and sealing where Schlup teaches the necessity of such an improvement in the hide and leather industries and laminated composites. See 1:10-20, 2:30-40, patented claims 1-15, Example 2, and Tables 1-2. Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials.

Schmoock teaches a leather-containing composite material used in structural composite materials in application of heat and/or pressure as a low-cost alternative (Abstract, 3:1-40). Such description of this material is considered equivalent to Applicant's claimed leather or bonded leather materials.

Hiers discloses the use of leather containing animal hides (see 1:6-9) for the hand and feel of natural leather (Abstract) in a non-woven composite (patented claims 1-2) (which is the same reason Applicant uses the leather material) under a hot press enduring heat and pressures of 225 to 500 degrees F and 5 to 500 lbs per sq. in. (see 12:20-30, Example 1, especially lines 45-50 of col. 13).

17. Nishi teaches a powdered leather comprised of at least 85% natural raw leather hide, which can be used and manufactured into a thin film, molded products, coatings or fibers (1:19-35, 2:5-40) and in general, laminates (10:1-68, 11:1-25, maximum 60% of natural raw leather powder, equivalent in meaning to decorative layer consisting essentially of leather material). The laminate uses the leather in the outermost skin layer, intermediate and substrate layers, where the substrate may be cloth, film, or paper. The leather contained products resultant therefrom the laminate exhibit good touch, and grip material having tactile quality (same reasons as Applicant).

It would have been obvious to one having ordinary skill in the art to have modified the

composite of Scher to use the leather composite material of Schlup for the purpose of improving several properties surrounding those effected by heat and pressure, namely toughness, machinability, compressibility and sealing where the such an improvement in laminated composites is needed in the hide and leather industries as taught by Schlup (1:10-20, 2:30-40, patented claims 1-15, Example 2, and Tables 1-2.

It would have been obvious to one having ordinary skill in the art to have modified the composite of Scher to use the leather composite material of Schmoock for the purpose of improving several properties surrounding those effected by heat and pressure where such an improvement in laminated composites is a low cost alternative to high-quality leathers as taught by Schmoock (3:1-45, Abstract).

It would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the woven or cloth embeddment layer of the laminate of Scher because leather containing animal hides as well as simulated leather have been conventionally used in the art of decorative articles for the hand and feel of natural leather in a non-woven heat and pressure composite, which is the same reason Applicant uses the leather material as cited above.

Additionally, it would have been obvious to one having ordinary skill in the art to have modified Scher also to include decorative leather material for Nishi's reasons such as good touch, and grip material having tactile quality.

Applicant is directed to the following note to the inclusion of leather material: Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar

elements according to known methods is likely to be obvious when it does no more than yield predictable results,” KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus, it is not a stretch to envisage leather material in a high pressure laminate as one having skill would expect leather material to aim at the purpose of making it feel soft-to-the-touch. It is well known that leather feels soft.

Also note to these points above regarding using leather material: Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozgek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness “from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.” *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

Regarding the thickness recitation per instant claim 7, Scher does not teach. However, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

The references above do not teach a migrated resin from the underlyer, however, since thermosetting resins are impregnated in the same fashion, this transition is expected.

- The Examiner applies the same rationale here as explained in detail above as Applicant submitted the same arguments to this rejection.

18. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher in view of Schlup or Schmoock or Hiers et al. or Nishi, as applied to claims 1 and 6 above, and further in view of Takeuchi et al.

The combination is relied upon above.

The combination is silent to a substrate of materials listed in claims 4 and 9.

Takeuchi teaches a decorative composite where the substrate is of a variety of materials, including that of Scher, paper and cellulosic sheet materials, and also all those listed in claims 4 and 9 (5:10-61), thereby teaching equivalent materials used for the same supportive purpose as a substrate applied in composites.

It would have been obvious to one having ordinary skill in the art to have modified the composite of the combinations to use plywood, medium density fiberboard, or particleboard because Takeuchi teaches they are equivalents to cellulosic sheets used as a substrate for composites (Takeuchi, 5:10-61, 12, Abstract).

- Applicant argues this rejection, the same rationale is applied here as described above.
- New reference made to Nishi provides a natural leather raw material used in over 50 wt. % in a variety of composites, materials, and fibers, should Applicant have support for using over 50 wt% and/or showing a deleterious effect.

- A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699,705, 222 USPQ 191, 196 (Fed. Cir. 1984). Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/
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